

REMARKS

Applicant respectfully requests reconsideration of the present application and allowance of the pending claims in view of this response. Claims 1-4, 6-9, 12-14, and 16 are pending in the present application. Claims 1, 6 and 12 have been amended. Claims 5, 10-11, 15, and 17 have been canceled and their limitations incorporated into independent claims 1 and 12. There are no new claims. Claims 1 and 12 are independent claims.

INFORMATION DISCLOSURE STATEMENT

Applicants acknowledge and thank the Examiner for the careful consideration of all of the references listed in the Information Disclosure Statements filed February 11, 2004 and April 11, 2005.

PRIOR ART REJECTIONS

35 U.S.C. § 102(b) Nuxoll Rejection

Claims 1-4, 6-9, 12-14, and 16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,307,769 to Nuxoll et al. This rejection is moot in light of the amendments to independent claims 1 and 12 to incorporate the subject matter of dependent claims 5 and 15, respectively. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 102(b) Yoda Rejection

Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Publication 9-223856 to Yoda et al. This rejection is moot in light of the amendments to independent claim 1, to incorporate the features of dependent claim 5. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 102(b) Yoshihara Rejection

Claim 12 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Publication 10-150295 to Yoshihara et al. This rejection is moot in light of the amendments to independent claim 12, to incorporate the features of dependent claim 15. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 102(b)/§ 103 Yoshihara Rejection

Claims 1 and 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious in view of Yoshihara. This rejection is moot in light of the amendments to independent claim 1 to incorporate the subject matter of dependent claim 5. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 103 Nuxoll/Nakano Rejection

Claims 5, 10-11, 15, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nuxoll et al. in view of U.S. Patent 4,733,461 to Nakano. Applicants respectfully submit that this rejection is moot with respect to dependent claims 5, 10-11, 15, and 17 as a result of the cancellation of these claims and further inapplicable to amended independent claims 1 and 12, incorporate the subject matter of dependent claims 5 and 15, respectively, for at least the reasons set forth below.

On page 6 of the Office Action, the Examiner acknowledges that Nuxoll et al. is silent with regard to having “*a number of the circuit boards sequentially connected to one another in a direction perpendicular to a direction in which the first and second chip mounting regions arrayed on each circuit board,*” and allegedly relies upon the teachings of Nakano to meet these limitations.

Lack of Motivation to Combine References

Applicant submits that the Examiner has not supplied evidence of the motivation necessary to lead one of ordinary skill in the art to combine the teachings of Nuxoll et al. and Nakano. Accordingly, absent such motivation, a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been established and the rejection must be withdrawn.

Applicant directs the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 175 F.3d

994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a). To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicants. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art
- (b) the knowledge of one of ordinary skill art, or
- (c) in some cases, the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. *Broad conclusory statements standing alone are not "evidence"*.

The alleged motivation for combining Nuxoll et al. and Nakano to reject amended independent claims 1 and 12, asserted by the Examiner, is: "to increase the capacity of the device that the circuit board constitutes."

Applicant asserts that the motivation alleged by the Examiner is based upon applicant's invention and is therefore improper hindsight. The Examiner has viewed the present application and selected prior art relating to "connecting circuit boards" without identifying or discussing any specific

evidence of motivation to combine the references, other than providing conclusory statements regarding the motivation and obviousness. Neither Nuxoll, nor Nakano suggest combining the features of amended independent claims 1 or 12, nor has the Examiner cited any particular passage of Nuxoll or Nakano, or provided evidence that such a combination would be obvious to one of ordinary skill in the art.

On the contrary, the disclosed references seek to overcome differing problems and therefore do not constitute an obvious combination. Nuxoll et al. discloses a device designed to eliminate the possibility of damage to the semiconductor device or testing device due to mismatching of the terminals when the circuit board is applied to the testing device (Nuxoll et al. column 4, lines 3-24). Nakano discloses a device designed to allow for the use of multiple separate circuit boards without the loss of surface space on the primary board (column 2, lines 18-23), through the use of special connector pins. Given, the distinct and differing problems solved by the two references, it would not have been obvious for one of ordinary skill in the art to combine the teachings of Nuxoll et al. and Nakano.

Therefore, withdrawal of the outstanding rejection is respectfully requested.

The disclosed combination fails to meet claimed features

Applicant further submits that even assuming *arguendo* that Nuxoll et al. could be combined with Nakano (which applicant does not admit), Nakano still

fails to account for the deficiencies of Nuxoll et al. as discussed above in regard to amended independent claims 1 and 12.

The Examiner argues that figure 24 and column 1, lines 10-25 of Nakano teaches "*a number of the circuit boards sequentially connected to one another in a direction perpendicular to a direction in which the first and second chip mounting regions arrayed on each circuit board*". However, applicant respectfully disagrees with the Examiner's conclusion.

As a result, any combination employing Nakano would only lead to the stacking of separate circuit boards connected through special sockets and pins (see Nakano figure 1), not to *the sequential connection of circuit boards* to create a larger "array printed circuit board" as disclosed in amended independent claims 1 and 12.

Accordingly, Applicants respectfully submit that neither Nuxoll et al. or Nakano, either alone or in combination, teach or suggest all of the limitations set forth in amended independent claims 1 or 12.

CONCLUSION

In view of above remarks and amendments, reconsideration of the outstanding rejection and allowance of the pending claims is respectfully requested.

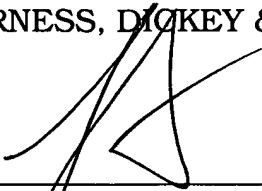
If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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